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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/781,739

02/20/2004

Satosi Imago

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ALEXANDRIA, VA 22314

EXAMINER

HAQ, NAEEM U

ART UNIT

PAPER NUMBER

3625

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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3 MONTHS

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/781,739

Applicant(s)

IMAGO, SATOSI

Examiner

Naeem Haq

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 13-20 and 23 is/are pending in the application.
- 4a) Of the above claim(s) 11, 12, 21, 22 and 24-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 13-20 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/7/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Claims 11, 12, 21, 22, and 24-49 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 28, 2006.

Claims 1-10, 13-20 and 23 will be considered for examination.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

These claims are directed to an "apparatus". However, the Applicant's specification discloses that the "service providing part" is a web service (see specification page 15, lines 20-21; page 17, lines 1-6). The examiner notes that a web service is nothing more than a program. Therefore, claims 1-10 lack any sort of physical structure that would constitute an "apparatus".

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As noted above, claims 1-10 are directed to an "apparatus". However, the claims lack any sort of physical structure that would constitute an "apparatus". Therefore, it is unclear what physical structure the Applicant is attempting to claim as part of the "apparatus". Furthermore, it is unclear to the examiner how a program alone can be considered as an "apparatus".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5-7, 10, 13, 14, 17, 18, 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Fisher et al. (US 6,243,691 B1) ("Fisher").

Referring to claims 1, 13, and 23: Fisher teaches a service information providing apparatus including a service providing part for providing a service which a user utilizes, wherein said service providing part includes a service information providing part

Art Unit: 3625

providing information concerning the service, the information utilized when the user selects the service, in response to a request from a user terminal (Figure 1, "210", "250"; Figure 2; col. 4, lines 30-43; col. 5, line 66 – col. 6, line 6).

Referring to claims 2, 7, and 14: Fisher teaches all the limitations of claim 1 as noted above. Furthermore, Fisher teaches that the service information providing part includes a service information obtaining part obtaining the information concerning the service from a service information storing part storing the information concerning the service (col. 5, lines 49-65).

Referring to claims 5 and 17: Fisher teaches all the limitations of claim 1 as noted above. Furthermore, Fisher teaches that the service information providing part includes a request analyzing part analyzing the request sent from the user terminal (col. 7, lines 20-35).

Referring to claims 6 and 18: Fisher teaches all the limitations of claim 1 as noted above. Furthermore, Fisher teaches that the service information providing part includes a response creating part creating a response including information concerning the service utilized when the user selects the service (col. 6, lines 15-26).

Referring to claim 10: Fisher teaches all the limitations of claim 1 as noted above. Furthermore, Fisher teaches that service providing apparatus is an image forming apparatus forming an image (Figure 1, "280").

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al. (US 6,243,691 B1) ("Fisher") in view of Official Notice.

Referring to claims 3, 4, 15, and 16: Fisher teaches all the limitations of claims a 1 and 2 as noted above. Fisher does not teach that the service providing part includes a search condition, and said service information providing part further includes a determining part based on the search condition whether or not the information concerning the service obtained by said service information obtaining part is information concerning the service required by the request. However, Official Notice is taken that it is old and well known in the art to use a search condition when retrieving information for a user. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the invention of Fisher. One of ordinary skill in the art would have been motivated to do so in order to allow a user to perform a search based on a search condition.

Claims 8, 9, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al. (US 6,243,691 B1).

Referring to claim 8, 9, 19 and 20: Fisher teaches all the limitations of claims a 1 and 7 as noted above. Fisher does not teach that the information concerning the service stored in said service information storing part is written in at least two languages, and the request includes language indication information indicating a language of the information of the service, the information to be included in a response corresponding to the request. However, the Examiner notes that this limitation is not functionally involved in the elements of the recited system. Therefore this limitation is deemed to be nonfunctional descriptive material. The elements of the apparatus would be the same regardless of what language the service was written in. The difference between the claimed invention and the prior art is merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to write the service of Fisher in whatever language the user desired because such information does not functionally relate to the elements of the claimed system and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Art Unit: 3625

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (571)-272-6758. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571)-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Naeem Haq, Primary Examiner
Art Unit 3625

December 11, 2006